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PATENT
Attorney Docket No.: 019941-001810US

TOWNSEND and TOWNSEND and CREW LLP

By: 

Judith Cotham

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yuuiki Tsutsui, et al.

Application No.: 10/674,581

Filed: September 29, 2003

For: IMMUNE RESPONSE
INDUCTION METHOD

Customer No.: 20350

Confirmation No. 5398

Examiner: Bruce D. Hissong

Technology Center/Art Unit: 1646

PETITION UNDER M.P.E.P. § 706.07(c)
1002.02(c) and 37 C.F.R. § 1.181

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Director of Technology Center 1600 to vacate the finality of the Office Action dated October 5, 2007 in the above-identified application as clearly being premature. In the Office Action, claims 7, 9, 13, 15, 19, and 31-39 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious, and the action was made final. Applicants submit the finality of the Office Action was clearly improper.

This petition is timely filed within two months of the date of the above-noted Office Action.

As set forth in M.P.E.P. § 706.07(b), a final rejection in a first Office Action is proper in very limited situations. M.P.E.P. § 706.07(b) provides:

[t]he claims of a new application may be finally rejected in the first Office action in those situations where... (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

In the present case, all claims of the new application (1) are NOT drawn to the same invention claimed in the earlier application, and therefore, the finality of the Office Action dated October 5, 2007 is clearly premature.

In the previous Office Action dated May 29, 2007, all claims were rejected and made final under 35 U.S.C. § 103(a) as allegedly being obvious in view of a combination of *Staats et al.* ("Staats," WO 00/20028) and Takasu (*Kurume Med. J.* 2001, 48: 171-174) as well as the combination of Foster *et al.* ("Foster," U.S. Patent No. 6,436,391) and Tovey (U.S. Patent No. 6,361,769).

Applicants' timely filed an amendment and Response on August 29, 2007. Applicants' Response included i) a Request for Continued Examination, ii) nine (9) new claims not previously examined, as well as iii) new arguments and an explanation of comparative data. These newly added claims *i.e.*, claims 31-39, recited additional features that were supported by the specification, but had not been previously examined. These features included for example, (1) the secretion of the vaccine antigen-specific antibody at the gastrointestinal mucosal surface; (2) the secretion of IgA as the antibody in blood; and (3) the secretion of IgG as the antibody at the gastrointestinal mucosal surface.

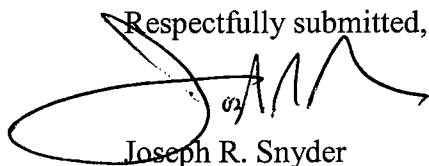
Despite Applicants' Response and newly added claims not drawn to the same invention claimed in the earlier application, the Office Action mailed October 5, 2007 repeated the previous rejections under 35 U.S.C. § 103(a) and made the rejection prematurely final. In fact, the Examiner admitted that the newly added features of the claims were not expressly taught by any of the references cited in the rejection: "...neither Staats nor Takasu specifically teach [the new limitations]...neither Foster nor Tovey specifically teach [the new limitations]." *See*

Office Action, page 4, paragraph 3, and page 6, paragraph 2. Instead, the new limitations were dismissed as obvious features of the prior invention:

However, it would be expected, in absence of evidence to the contrary, that a nasally administered composition comprising a vaccine antigen and an IFN- α adjuvant, as is obvious in view of [the cited references], would induce vaccine-antigen specific antibodies at the gastrointestinal mucosal surface and in the blood, wherein said antibodies are IgA and IgG, respectively. (Office Action, p. 4, paragraph 3, and p. 6, paragraph 2)

This reasoning ignores that in order to establish a *prima facie* case of obviousness, there must be some teaching or suggestion of each of the claimed features. In addition, the instant rejection fails to establish that all claims of the pending application are drawn to the same invention claimed in the earlier application, and therefore it does not meet the requirements for final rejection as set forth in M.P.E.P. § 706.07(b). The finality of the rejection of the claims set forth in the Office Action of October 5, 2007, is therefore clearly improper and thus, premature. As such, the Director is respectfully requested to grant this petition and vacate the finality of the Office Action.

Applicants believe that no fee is required for submission of this petition. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,

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